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EXAMINER

FISHER, ABIGAIL L

ART UNIT

PAPER NUMBER

1616

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,030	Applicant(s) ARIOTTO ET AL.	
	Examiner ABIGAIL FISHER	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of Amendments/Remarks filed on November 18 2009 is acknowledged. Claims 2-3 were/stand cancelled. Claims 1 and 10 were amended. Claims 11-12 were added. Claims 1 and 4-12 are pending. Claims 5-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse provisionally on June 25 2009 and affirmed in the response filed on November 18 2009. Claims **1, 4 and 7-12** are directed to the elected invention.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 1-4 and 7-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in light of Applicants' amendments filed on November 18 2009.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 1, 3-4, 7-10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Willman et al. (WO 95/33025) is **withdrawn** in light of Applicants' amendments filed on November 18 2009.

The rejection of claims 1-4 and 7-10 under 35 U.S.C. 103(a) as being unpatentable over Knochel et al. (US Patent No. 4946618) in view of Kacher et al. (US Patent No. 5227086) is **withdrawn** in light of Applicants' amendments filed on November 18 2009.

Claims 1, 4, 7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Journal of Toxicology (2001) in view of Methmanus-Spaltro (US Patent No. 6162775).

Applicant Claims

The instant application claims a composition comprising one or more oily substances at a total concentration within the range of between 30 and 70% by weight relative to the composition and a surfactant at a total concentration of between 10 and 40% by weight relative to the composition. The surfactant as claimed is an N-cocoyl sarcosinate, N-oleoyl sarcosinate or mixture thereof.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

International Journal of Toxicology is directed to a report on the safety assessment of various acyl sarcosinates including cocoyl sarcosinate, oleoyl

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sarcosinate as well as the corresponding sodium and ammonium salts. The acyl sarcosinates and sarcosinates function as hair-conditioning agents and surfactant-cleansing agents in cosmetic formulations (page 5, left column, use-cosmetic). The sarcosinates are used at concentrations of 2.78 to 12.9% in soaps (page 12, right column, summary, first paragraph). Cocoyl sarcosine is known to reduce moisture loss from the skin through the formation of a hydrophobic protective layer on the surface of the epidermis (page 12, left column, second paragraph).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

While the International Journal of Toxicology report teaches that acyl sarcosines and sarcosinates are utilizing in cosmetics, the International Journal of Toxicology does not specify the components of the cosmetic formulations. However, this deficiency is cured by Methmanus-Spaltro.

Methmanus-Spaltro is directed to anhydrous liquid cosmetic compositions comprising glycerin and polyalkylene glycol. The composition comprises an anionic surfactant, glycerine, polyethylene glycol and a water insoluble benefit agent (column 1, lines 40-45). Examples of anionic surfactants include acyl sarcosinates (column 1, line 60). The composition of the invention can also comprise nonionic surfactants such as polyoxyethylene alkyl ethers (ethoxylated fatty alcohols) (column 4, lines 64-67 and column 5 lines 11-16). It is taught that conveniently, the blend of surfactants in compositions according to the invention is selected so as to enhance the lather volume and rinsability of the composition (column 5, lines 36-38). The compositions comprise

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glycerin at a level of 5 to 25% and polyethylene glycols in an amount of 20 to 70% by weight (column 6, lines 1-14). Compositions according to the invention contain a maximum of 1% by weight of water. The anionic surfactant is present in an amount of at least 10% wherein 40 to 100% of the surfactants in the composition are anionic surfactants (claims 4-5). Exemplified amount of surfactant is 11% (example 2).

***Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of International Journal of Toxicology and Methmanus-Spaltro and utilize the acyl sarcosinates such as oleoyl or cocoyl sarcosinate in the cleansing composition of Methmanus-Spaltro. One of ordinary skill in the art would have been motivated to utilize the sarcosinates in this type of composition as the International Journal of Toxicology teaches that the sarcosinates are surfactant-cleansing compositions and are known to be utilized in cosmetic compositions and Methmanus-Spaltro teaches cleansing compositions which comprise anionic surfactants and types of anionic surfactants taught include acyl sarcosinates. Therefore, one of ordinary skill in the art would have a reasonable expectation of success as these are cleansing compositions known to be utilized with acyl sarcosinates.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of International Journal of Toxicology and Methmanus-Spaltro and utilize nonionic surfactants such as ethoxylated alcohols in combination with the anionic surfactants. One of ordinary skill in the art would have

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been motivated to utilize the nonionic surfactants as Methmanus-Spaltro teaches utilizing them in combination with the anionic surfactants. One of ordinary skill in the art would have been motivated to utilize the nonionic surfactants so as to enhance the lather volume and rinsability of the composition as taught by Methmanus-Spaltro.

Regarding the claimed oils and amount of oils, the instant specification teaches that oily substances include those which are soluble at ambient temperature (page 1 of the specification). The amount of glycerin and propylene glycol (which are both liquid at room temperature) taught by Methmanus-Spaltro overlaps that instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Regarding the claimed amount of surfactant, International Journal of Toxicology and Methmanus-Spaltro teach amounts that overlap those instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1, 4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber et al. (US Patent No. 5653988) in view of International Journal of Toxicology.

Applicant Claims

The instant application claims a composition comprising one or more oily substances at a total concentration within the range of between 30 and 70% by weight relative to the composition and a surfactant at a total concentration of between 10 and 40% by weight relative to the composition. The surfactant as claimed is an N-cocoyl sarcosinate, N-oleoyl sarcosinate or mixture thereof.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Gerber et al. is directed to a shower oil. The formulations comprise not more than 55% by weight of a surfactant selected from various fatty compounds such as fatty alcohol ethoxylates and a content of not less than 45% by weight based on the formulation of one or more oil components selected from group of oils with a high content of triglycerides and optionally contains further surfactants and further cosmetic or pharmaceutical auxiliaries and the formulations are essentially anhydrous (abstract).

Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)

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While Gerber et al. teach additional surfactants can be added, Gerber et al. do not specify the surfactants are acyl sarcosinates. However, this deficiency is cured by International Journal of Toxicology.

International Journal of Toxicology is directed to a report on the safety assessment of various acyl sarcosinates including cocoyl sarcosinate, oleoyl sarcosinate as well as the correspond sodium and ammonium salts. The acyl sarcosines and sarcosinates function as hair-conditioning agents and surfactant-cleansing agents in cosmetic formulations (page 5, left column, use-cosmetic). The sarcosinates are used at concentrations of 2.78 to 12.9% in soaps (page 12, right column, summary, first paragraph). Cocoyl sarcosine is known to reduce moisture loss from the skin through the formation of a hydrophobic protective layer on the surface of the epidermis (page 12, left column, second paragraph).

***Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Gerber et al. and International Journal of Toxicology and utilize acyl sarcosinates as the additional surfactants in the cleansing compositions of Gerber et al. One of ordinary skill in the art would have been motivated to utilize acyl sarcosinates as Gerber et al. teach other surfactants can be added and the International Journal of Toxicology teaches that acyl sarcosinates are known to be utilized in cleansing compositions. Furthermore, one of ordinary skill in the art would

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have been motivated to add cocoyl sarcosine in order to reduce moisture loss from the skin as taught by International Journal of Toxicology.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Gerber et al. and International Journal of Toxicology and utilize ethoxylated fatty alcohols as a surfactant. One of ordinary skill in the art would have been motivated to utilize ethoxylated fatty alcohols as they are specific surfactant taught by Gerber et al. It would have been obvious to one of ordinary skill in the art to try any of the specifically taught surfactants as a person with ordinary skill has good reason to pursue known options within his or her technical grasp. **Note: MPEP 2141 [R-6]** *KSR International CO. v. Teleflex Inc.* 82 USPQ 2d 1385 (Supreme Court 2007).

Regarding the claimed amount of oils, Gerber et al. teach an amount that overlaps that instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5]**

Regarding the claimed amount of surfactant, International Journal of Toxicology teaches an amount that overlaps that instantly claimed. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best

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achieve the desired results. It would have been obvious to one of ordinary skill in the art to adjust the amount of sarcosinate utilized depending on the desired cleansing effect as well as determine the amount that effectively reduce moisture loss from the skin. It would have been obvious to one of ordinary skill in the art at the time of the invention to engage in routine experimentation to determine optimal or workable ranges that produce expected results. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F. 2d 454, 105 USPQ 233 (CCPA 1955).

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1, 4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Journal of Toxicology in view of Stork et al. (US Patent No. 6620773).

Applicant Claims

The instant application claims a composition comprising one or more oily substances at a total concentration within the range of between 30 and 70% by weight relative to the composition and a surfactant at a total concentration of between 10 and 40% by weight relative to the composition. The surfactant as claimed is an N-cocoyl sarcosinate, N-oleoyl sarcosinate or mixture thereof.

**Determination of the Scope and Content of the Prior Art
(MPEP §2141.01)**

International Journal of Toxicology is directed to a report on the safety assessment of various acyl sarcosinates including cocoyl sarcosinate, oleoyl sarcosinate as well as the correspond sodium and ammonium salts. The acryl sarcosines and sarcosinates function as hair-conditioning agents and surfactant-cleansing agents in cosmetic formulations (page 5, left column, use-cosmetic). The sarcosinates are used at concentrations of 2.78 to 12.9% in soaps (page 12, right column, summary, first paragraph). Cocoyl sarcosine is known to reduce moisture loss from the skin through the formation of a hydrophobic protective layer on the surface of the epidermis (page 12, left column, second paragraph).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

While the International Journal of Toxicology report teaches that acyl sarcosines and sarcosinates are utilizing in cosmetics, the International Journal of Toxicology does not specify the components of the cosmetic formulation. However, this deficiency is cured by Stork et al.

Stork et al. is directed to a foaming oil preparation and its use. The compositions comprise at least a surfactant mixture and an oil component, the surfactant mixture comprising at least an anionic or zwitterionic surfactant, a nonionic surfactant and an alkyl phosphate (abstract). The proportion of the surfactants is from 15 to 50% and that of the oil component is from 50 to 85%. The composition can be essentially water free

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(column 1, lines 62-67). Examples of nonionic surfactants include fatty alcohol ethoxylates (column 2, lines 51-55). The content of the nonionic surfactant is from 1 to 28% (column 2, lines 44-46). The anionic surfactant content is from 0.1 to 30% (column 2, lines 4-6). The oil component is chosen from natural oils, modified oils, paraffin oil, ester oils and silicone oils (column 4, lines 25-29).

***Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of International Journal of Toxicology and Stork et al. and utilize the acyl surfactants as the anionic surfactants in the compositions of Stork et al. It would have been obvious to one of ordinary skill in the art to utilize acyl sarcosinates in the composition of Stork et al. as International Journal of Toxicology teach that they are utilized in cleansing cosmetic compositions and Stork et al. teach that the cleansing compositions comprise anionic surfactants. One of ordinary skill in the art would have been motivated to select the anionic surfactant cocoyl sarcosinate for the added benefit of reduced moisture loss from the skin as taught by International Journal of Toxicology.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of International Journal of Toxicology and Stork et al. and utilize ethoxylated fatty alcohols as the nonionic surfactant. One of ordinary skill in the art would have been motivated to utilize ethoxylated fatty alcohols as nonionic surfactants are required and ethoxylated fatty alcohols are a specific choice of

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nonionic surfactants. It would have been obvious to one of ordinary skill in the art to try any of the specifically taught nonionic surfactants as a person with ordinary skill has good reason to pursue known options within his or her technical grasp. **Note: MPEP 2141 [R-6]** *KSR International CO. v. Teleflex Inc.* 82 USPQ 2d 1385 (Supreme Court 2007).

Regarding the claimed amounts of surfactant and oils, Stork et al. teach an amount that overlaps that instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5]**.

Response to Arguments

Applicant's arguments with respect to claims 1, 4 and 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1616

AF

/Mina Haghighatian/
Primary Examiner, Art Unit 1616